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EXAMINER				
MEMBERU, BENIYAM				
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2625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/006,530

**Applicant(s)**

AKIMOTO ET AL.

**Examiner**

BENIYAM MENBERU

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/29/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 29, 2008 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 10, 16-19 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7, 8, 10, 13, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6633399 to Fukazawa.

Regarding claim 1, Rachelson '706 discloses a communication apparatus comprising:

registration means for registering an electronic mail account of a client via a first network upon receiving a request from the client (column 8, lines 3-15; The address book is the registration means. The request occurs when e-mail is received from someone the first time.), wherein the request includes a customized format of an image to be received (column 10, lines 21-31; see "recipient preferences" ; column 11, lines 21-29; Figure 2, the administrator 100 communicates over Internet);

reception means for receiving facsimile data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2; );

confirming means for confirming whether the client maintains a valid account (column 11, lines 12-18; column 8, lines 21-27) ;

generating means for generating an electronic snail directed to the client's account (column 11, lines 21-29; outgoing e-mail) where the electronic mail has an attachment generated based on the received facsimile data (column 11, lines 21-29; "received fax message") received by said reception means (The FAX server 200 is the reception means for facsimile reception from FAX 110. In Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU Attachment". Further this goes as output of SMTP

server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10, lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments are processed for incoming emails which are converted to facsimile data.), and also based on the customized format of an image for the client received by said registration means (Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient. see also column 10, lines 23-31;); and transmission means for transmitting the electronic mail generated by said generating means to the client's electronic mail account (column 11, lines 30-28). However Rachelson '706 does not disclose wherein data includes color image information and/or monochrome image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64; color image is received at destination "PHOTOWORKS").

Having the system of *Rachelson '706* and then given the well-established teaching of *Blair et al '524*, it would have been obvious to one of ordinary skill in the art

at the time of the invention was made to modify the system of **Rachelson '706** as taught by **Blair et al '524**, since **Blair et al '524** stated in pages 3-4, paragraph 30, such a modification would provide color image transmission to different selectable destinations as needed.

However Rachelson '706 does not disclose wherein the customized format includes information regarding whether to divide the image into several pages to create one file from each page or to group all pages of the image into a single file, for attaching to the electronic mail.

Fukazawa '399 discloses wherein the customized format includes information regarding whether to divide the image into several pages to create one file from each page or to group all pages of the image into a single file, for attaching to the electronic mail (column 2, lines 63-67; column 3, lines 13-27, 31-44; data file can be divided by the PC4; column 3, lines 60-67; Data file can be divided into page units. Column 5, lines 6-34; received mail can be divided or undivided format; In step s7 the single file is printed.).

Having the system of **Rachelson '706** and then given the well-established teaching of Fukazawa '399, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by Fukazawa '399, since Fukazawa '399 stated in col. 3, Lines 31-39, such a modification would improve the speed of transmission for large files.

Regarding claim 2, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 1. Further Rachelson discloses the

communication apparatus according to claim 1, wherein said generating means attaches an image received by said reception means to the electronic mail (column 11, lines 21-29; column 10, lines 40-49).

Regarding claim 7, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 1. Further Rachelson discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on an encoding system of said attached image (column 11, lines 25-29).

Regarding claim 8, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 1. Further Blair et al discloses the communication apparatus according to claim 1, wherein said reception means receives the color and/or monochrome image information based on a facsimile procedure (page 5, paragraph 48, page 6-7, paragraph 64; page 4, paragraph 30, lines 5-7).

Regarding claim 10, Rachelson discloses a communication apparatus comprising:

registration means for registering electronic mail accounts of a plurality of clients (column 10, lines 23-31; "recipients " read on plurality of clients) via a first network upon receiving requests from each of the plurality of clients (column 8, lines 3-15; The address book is the registration means. The request occurs when e-mail is received from someone the first time.), wherein each of the requests includes a customized

format of an image to be received (column 10, lines 21-31; see "recipient preferences" ; column 11, lines 21-29; Figure 2, the administrator 100 communicates over Internet);

reception means for receiving facsimile data, from a second network that uses a different communication protocol from the first network (column 10, lines 65-67; column 11, lines 1-10; Figure 1, the fax 110 is connected to telephone system 103 and the EPO is connected to an Internet; EPO receives fax data from 103 as shown in Figure 2);

management means for validating the registered electronic mail accounts (column 11, lines 12-18; column 8, lines 21-27; validation occurs when determination is made whether the recipient is new or not (ever received email).) and generating electronic mails for the validated electronic mail accounts (column 11, lines 21-29; column 8, lines 26-27; column 2, lines 33-42) where the electronic mail has an attachment generated based on the received facsimile data received by said reception means (The FAX server 200 is the reception means for facsimile reception from FAX 110. In Figure 2, for "OUTGOING MAIL" procedure, "TIF Image of the FAX" as shown in Figure 2 as output of FAX server 200 goes to Mail Processor 202, where it clearly shows as an output of 202 "EMAIL message with TIF as MIME or UU Attachment". Further this goes as output of SMTP server as "OUTGOING Email Message" to destination 120. Thus the attachment for the EMAIL is based on the TIF image of Fax as shown. Figure 12 shows the OUTGOING Mail process. Although in Figure 12, the attachment is not discussed it is clear from Figure 2, that there is attachment of the facsimile image data. Further in column 10, lines 40-59, in the INMAIL process which is opposite of OUTGOING Mail process discussed above, attachments



are processed for incoming emails which are converted to facsimile data.), and also based on the customized format of an image for each of the plurality of clients received by said registration means (Further with respect to the "customized format of an image for the client received by said registration means", Figure 12, shows step 1216 which does conversion to "preferred format" (customized format) of the recipient (column 11, lines 21-29), wherein preferred formats GIF, UU, Encode, MIME, Postscript and TIF (as default). The "recipient database" reads on the registration means, since the "recipient database" has information about the preferred format of the recipient. see also column 10, lines 23-31; and

transmission means for transmitting the generated electronic mails to each of the clients' electronic accounts validated by said management means (column 11, lines 30-28; column 8, lines 26-27; column 2, lines 33-42 ). However Rachelson does not disclose data which includes color image information and/or monochrome image information.

Blair et al discloses receiving color image information (page 5, paragraph 48, page 6-7, paragraph 64; color image is received at destination "PHOTOWORKS").

Having the system of *Rachelson '706* and then given the well-established teaching of *Blair et al '524*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *Rachelson '706* as taught by *Blair et al '524*, since *Blair et al '524* stated in pages 3-4, paragraph 30, such a modification would provide color image transmission to different selectable destinations as needed.

However Rachelson '706 does not disclose wherein the customized format includes information regarding whether to divide the image into several pages to create one file from each page or to group all pages of the image into a single file, for attaching to the electronic mail.

Fukazawa '399 discloses wherein the customized format includes information regarding whether to divide the image into several pages to create one file from each page or to group all pages of the image into a single file, for attaching to the electronic mail (column 2, lines 63-67; column 3, lines 13-27, 31-44; data file can be divided by the PC4; column 3, lines 60-67; Data file can be divided into page units. Column 5, lines 6-34; received mail can be divided or undivided format; In step s7 the single file is printed.).

Having the system of **Rachelson '706** and then given the well-established teaching of Fukazawa '399, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Rachelson '706** as taught by Fukazawa '399, since Fukazawa '399 stated in col. 3, Lines 31-39, such a modification would improve the speed of transmission for large files.

Regarding claim 13, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 10. Further Rachelson discloses the communication apparatus according to claim 10, wherein said management means is capable of managing a plurality of electronic mail accounts registered at said registration means (column 8, lines 15-28; Figure 9a).

Regarding claim 16, see Rejection of claim 1 as shown above. The apparatus of

Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 render obvious the method disclosed in claim 16.

Regarding claim 18, see Rejection of claim 1 as shown above. The apparatus of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 render obvious the programming step disclosed in claim 18.

Regarding claim 17, see Rejection of claim 10 as shown above. The apparatus of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 render obvious the method disclosed in claim 17.

Regarding claim 19, see Rejection of claim 10 as shown above. The apparatus of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 render obvious the programming step disclosed in claim 19.

5. Claims 5, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6633399 to Fukazawa further in view of U.S. Patent No. 6658456 to Shimoosawa.

Regarding claim 5, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 1. However Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail.

Shimoosawa '456 discloses the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether or not to attach the image to the electronic mail (column 5, lines 13-20).

Having the system of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 and then given the well-established teaching of **Shimoosawa '456**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399, since **Shimoosawa '456** stated in Figure 4, and column 5, lines 13-29, such a modification would provide destination based processing of received data.

Regarding claim 12, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 10. Further Shimoosawa '456 discloses the communication apparatus according to claim 10, wherein said management means manages whether to transmit only text (column 8, lines 50-61), transmit only attachment file (column 10, lines 55-67) or transmit both the text and the attachment file of the received data (column 9, lines 62-67; column 10, lines 1-16).

Regarding claim 14, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 10. Further Shimoosawa disclose the communication apparatus according to claim 10, wherein said management means manages whether or not one of the registered email accounts is a mobile terminal (Shimoosawa discloses that mobile PDA can be used as recipient of email data (column 1, lines 24-29; column 8, lines 48-55; column 9, lines 1-13)).

Regarding claim 15, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 further in view of Shimoosawa '456 teach all the limitations of claim 14. Further Shimoosawa disclose the communication apparatus according to claim 14, wherein said management means manages the setting in case of forwarding an electronic mail to the mobile terminal (Shimoosawa teaches that when transferring data to mobiles like PDA, the attachments can be excluded from the data sent to prevent the PDAs from becoming memory full (column 8, lines 48-67)).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6633399 to Fukazawa further in view of U.S. Patent No. 6721783 to Blossman et al.

Regarding claim 6, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teach all the limitations of claim 1. However Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 does not disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image.

Blossman et al disclose the communication apparatus according to claim 1, wherein the customized format of an image includes information on whether to attach all or a part of said received image (Blossman et al disclose method of sending bank customers images of bank related documents through email based on customer preference on which documents to be sent (column 16, lines 1-5, lines 23-33, lines 45-54)).

Having the system of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 and then given the well-established teaching of **Blossman et al '783**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 as taught by **Blossman et al '783**, since **Blossman et al '783** stated in column 4, lines 38-41, such a modification would provide a destination specific transmission of important documents based on preference of users.

7. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6633399 to Fukazawa further in view of U.S. Patent No. 6883016 to Fujii et al.

Regarding claim 9, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teaches all the limitations of claim 8. However Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 does not disclose the communication apparatus according to claim 8, wherein said facsimile procedure is based on the ITU-T T. 37 recommendation.

Fujii et al '016 disclose facsimile procedure based on the ITU-T T. 37 recommendation (column 1, lines 15-24).

Having the system of Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 and then given the well-established teaching of **Fujii et al '016**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Rachelson '706 in view of Blair et al '524 further in view of

Fukazawa '399 as taught by *Fujii et al '016*, since *Fujii et al '016* stated in column 1, lines 20-23, such a modification would provide image transmission through email using ITU-T T.37 standard which is required.

Regarding claim 11, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teaches all the limitations of claim 10. Further Fujii et al '016 disclose the communication apparatus according to claim 10, wherein said reception means executes a reception process based on the ITU-T T. 37 recommendation (column 1, lines 13-24; "transmit and receive").

8. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6157706 to Rachelson in view of U.S. Patent Application Publication Pub. No. US 2002/0075524 A1 to Blair et al further in view of U.S. Patent No. 6633399 to Fukazawa further in view of U.S. Patent No. 6356356 to Miller, Jr et al.

Regarding claim 20, Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 teaches all the limitations of claim 1. Rachelson '706 does disclose transmission of electronic mail based on information registered at said registration means (column 8, lines 4-14, 21-29; the address book is the registration means which registers information (email address)). However Rachelson '706 in view of Blair et al '524 further in view of Fukazawa '399 does not disclose the communication apparatus according to claim 1, wherein said transmission means transmits the electronic mail generated by said generating means to a plurality of clients based on information.

Miller, Jr et al '356 discloses transmitting the electronic mail generated by said generating means to a plurality of clients based on information (column 5, lines 54-67;

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column 6, lines 1-8; "more than one destination" reads on plurality of clients; the information stored in step 46 is the information used for transmission to plurality of clients.).

Having the system of *Rachelson '706 in view of Blair et al '524* and then given the well-established teaching of *Miller, Jr et al '356*, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of *'706 in view of Blair et al '524* as taught by *Miller, Jr et al '356*, since *Miller, Jr et al '356* stated in col. 4, lines 43-55, such a modification would provide "broadcasting" capabilities for facsimile to email transmission.

Regarding claim 21, see rejection of claim 20 as shown above. The apparatus of *Rachelson '706 in view of Blair et al '524* further in view of *Fukazawa '399* further in view of *Miller, Jr et al '356* render obvious the method disclosed in claim 21.

Regarding claim 22, see rejection of claim 20 as shown above. The apparatus of *Rachelson '706 in view of Blair et al '524* further in view of *Fukazawa '399* further in view of *Miller, Jr et al '356* render obvious the programming step disclosed in claim 22.

### ***Other Prior Art Cited***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6859213 to Carter discloses email attaching method.

U.S. Patent No. 6275850 to Beyda et al discloses email attachment processing.

U.S. Patent No. 6327612 to Watanabe discloses email system.



U.S. Patent No. 6078921 to Kelley discloses file processing system.

U.S. Patent No. 6101548 to Okada discloses facsimile system.

U.S. Patent No. 7089286 to Malik discloses compression for email attachments.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENIYAM MENBERU whose telephone number is (571) 272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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***Patent Examiner***

Beniyam Menberu

/Beniyam Menberu/  
Examiner, Art Unit 2625

07/30/2008

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625